

REMARKS/ARGUMENTS

In the restriction/election of species requirement dated March 19, 2008, the Examiner delineated the following inventions as being patentably distinct:

Group I, Claims 1, 3-5, 8, 10, and 11, drawn to an isolated nucleic acid, a plasmid, vector, micro-organisms, and a method of preparing a polypeptide;

Group II, Claims 2, 6, and 7, drawn to a polypeptide; and

Group III, Claim 9, drawn to a process of using a polypeptide to make a branched-chain amino acid.

The Examiner further required the election of a single species.

Applicants provisionally elect Group I (Claims 1, 3-5, 8, 10, and 11) and the species SEQ ID NO: 1 both with traverse.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction. Composition and method of use should be examined together. It is a technical relationship that defines the contribution which each of the Groups taken as a whole makes over the prior art.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing "Markush" language. The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the Markush group need only possess at least one property in common which is mainly responsible for the function in the claimed relationship. The

same entity in a generic sense suffices. The accepted expression for a Markush group is “selected from the group consisting of”.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and independent inventions.”

Applicants submit that a search of all the claims would not constitute a serious burden on the Office.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants request that if the invention of Group I is found allowable, withdrawn Groups II and III which include all the limitation of the allowable claims be rejoined.

Applicants further request that should the elected species be found allowable, the Examiner expand the search to include all the non-elected species.

Divisional applications filed thereafter claiming the non-elected species should not be subject to a double patenting ground of rejection. 35 U.S.C. § 121, In re Joyce (Comr. Pat. 1957) 115 USPQ 412.

Applicants submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

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